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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,783	08/28/2001	Brian J. Petryna	PETRYNA 8	3916
27964 HITT GAINES P.C. P.O. BOX 832570 RICHARDSON, TX 75083	7590 01/22/2010			
EXAMINER				
LEE, ANDREW CHUNG CHEUNG				
ART UNIT		PAPER NUMBER		
2476				
NOTIFICATION DATE		DELIVERY MODE		
01/22/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@hittgaines.com

Office Action Summary**Application No.**

09/940,783

Applicant(s)

PETRYNA, BRIAN J.

Examiner

Andrew C. Lee

Art Unit

2476

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

In view of the Appeal Brief filed on 10/23/2009, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Ayaz R. Sheikh/

Supervisory Patent Examiner, Art Unit 2476

_____.

Ayaz Sheikh, Supervisory Patent Examiner, AU 2476

DETAILED ACTION

Response to Amendment

1. Claims 1 – 21 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 – 7, 8 – 14, 15 – 21, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding Independent claims 1, the amended claim subject matters of “subsequent telephone call over a computer network from a second caller to a first caller”, “calling number identification signal of said first caller”, “from said first caller to said second caller”, a destination address of said first caller”, and “subsequent telephone call over a computer network from said second caller to said first caller” are not disclosed and were not described in the specification at the time the application was originally filed. Since the claims 2 – 7 are dependent upon independent claim 1, the claims are rejected are rejected under 35 U.S.C. 112, first paragraph as well.

Regarding Independent claims 8, the amended claim subject matters of "subsequent telephone call over a computer network from a second caller to a first caller", "from said first caller to said second caller", said destination address of said first caller" are not disclosed and were not described in the specification at the time the application was originally filed. Since the claims 9 – 14 are dependent upon independent claim 1, the claims are rejected are rejected under 35 U.S.C. 112, first paragraph as well.

Regarding Independent claims 15, the amended claim subject matters of "a first telephone call from a first caller", "a destination address of said first caller", "a sequent telephone call to said first caller", said destination address of said first caller" are not disclosed and were not described in the specification at the time the application was originally filed. Since the claims 16 – 21 are dependent upon independent claim 1, the claims are rejected are rejected under 35 U.S.C. 112, first paragraph as well.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what/which a first caller and second caller referring to. The drawings and the specification do not provide enough information and explicit description for whether a first caller or a second caller is a calling side (caller) and called side (callee), whether a first caller or a second caller is a

plain old telephone (POT) or a personal computer. Clarification and appropriate action are required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 – 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scott et al. (US 6760324 B1) in view of Hon (US 6760020 B1).

Regarding claims 1, 8, 15, Scott et al. disclose a system, method, computer for automatically initiating a telephone call over a computer network (*"allows traffic originating on a circuit-switched network to be carried over a packet-switched network"* interpreted as initiating a telephone call over a computer network; col. 6, lines 24 – 37, Abstract, lines 1 – 6; Fig. 2, elements 202, 205, 207, 210, 215, 220, 205, 291), comprising: an address interceptor, associated with a station of a circuit-switched telephone network (*"Gateway server performing bridging of calls between the traditional telecommunication network and IP network, and to translate numbers and routing those numbers to the correct destination gateway"* correlates to an address interceptor, associated with a station of a circuit-switched telephone network; Fig. 2, elements 220, 210, gateway server, column 8, lines 37 – 55; element 291, 292 *"an ordinary telephone coupling to PSTN"*; element 205, *"PSTN"*; column 11, lines 45 –

55), that receives calling number identification signals of said first caller from a first telephone call from said first caller to said second caller over said circuit-switched telephone network (*"ANI information or caller ID information" correlates to receives calling number identification signals from said circuit-switched telephone network via a first telephone call; col. 53, lines 51 – 58, col. 61, lines 1 – 8*); and,

Scott et al. also disclose a network call initiator (*interpreted as routing server*), coupled to said address interceptor and associated with a computer network terminal that employs said destination address to automatically initiate said subsequent telephone call to said destination address via said computer network terminal (*"all routes to be configured on the routing server, but automatically distributed to the appropriate gateways and can be also distribute E.164 translation data" interpreted as associated with a computer network terminal that employs said destination address to automatically initiate said subsequent telephone call to said destination address via said computer network terminal; Fig. 3B, col. 8, lines 60 – 64; element "routing server"; col. 9, lines 1 – 12; col. 59, lines 60 – 65; col. 61, lines 41 – 45; lines 17 – 19; lines 25 – 55; col. 70, lines 15 – 35*).

Scott et al. do not disclose explicitly extracting from said calling number identification signals a destination address of said first caller for said subsequent telephone call from said second caller to said first caller.

Hon discloses extracting from said calling number identification signals a destination address of said first caller for said subsequent telephone call from said second caller to said first caller (*"dial remote device phone number", "" interpreted as*

calling number identification, "REMOTE_ID" as destination address; Fig. 2, Fig. 3A, Abstract, col. 5, lines 9 – 17, col. 6, lines 27 – 46).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Scott et al. to include the features of extracting from said calling number identification signals a destination address of said first caller for said subsequent telephone call from said second caller to said first caller as taught by Hon in order to provide a method for facilitating Internet Telephony, and more specifically, to the method of connecting Internet Telephony (*as suggested by Hon, see col. 1, lines 8 – 10*).

Regarding claims 2, 9, 16, Scott et al. disclose the limitation of a system, method, computer as recited in claimed wherein said calling number identification signals and said destination address are associated with a single location (*"caller ID information" correlates to said calling number identification signals, and "Destination Number type and Destination number Plan" correlates to destination address are associated with a single location; col. 53, lines 51 – 58; col. 61, lines 1 – 9*).

Regarding claims 3, 10, 17, Scott et al. disclose the limitation of a system, method, computer as recited in claimed wherein said destination address is selected from the group consisting of: a telephone number (col. 69, lines 37 – 41; col. 70, lines 2 – 8), an Internet Protocol address (col. 39, lines 16 – 17), a Voice over Internet Protocol (VoIP) gateway address (col. 11, line 52; col. 74, lines 3 – 5), and a VoIP gateway address combined with a telephone number (col. 73, lines 41 – 56; lines 66 – 67; col. 74, lines 1 – 5).

Regarding claims 4, 11, 18, Scott et al. disclose the limitation of a system, method, computer as recited in claimed wherein said computer network is the Internet (*Fig. 1B, element 120; Fig. 2, element 215; col. 1, lines 56 – 57*).

Regarding claims 5, 12, 19, Scott et al. disclose the limitation of a system, method, computer as recited in claimed wherein said station leaves unanswered a call transmitting said calling number identification signals (*col. 53, lines 43 – 47; lines 51 – 58, elements Unanswered Rings, Caller ID information can be associated with each port of the MSI/SC*).

Regarding claims 6, 13, 20, Scott et al. disclose the limitation of a system, method, computer as recited in claimed wherein said calling number identification signals are associated with a second station, said second station hanging up after a predetermined number of unanswered rings (*col. 50, lines 38 – 40, lines 43 – 46; “wait for maximum number of rings on the outbound call before it gives up, outbound call” correlates to the second station hanging up after a predetermined number of unanswered rings; col. 53, lines 43 – 47*).

Regarding claims 7, 14, 21, Scott et al. disclose the limitation of a system, method, computer as recited in claimed wherein said station and said computer network terminal are embodied in a computer (*Fig. 2, elements 210, 220; col. 6, lines 38 – 42*) and wherein a single telephone line alternatively couples said station to said circuit-switched telephone network (*Fig. 2, elements 201, 202, 205; col. 6, lines 30 – 36*) and said computer network terminal to said computer network (*Fig. 2, elements 293, 215; col. 4, lines 9 – 17, personal computers, to be on the same local area network (LAN) as long as they are connected via an IP network*).

Response to Arguments

6. Applicant's arguments filed on 10/23/2009 with respect to claims 1 – 21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Petras et al. (US 6215784 B1).
- b) Takahara et al. (6078583).
- c) Oran (US 6275574 B1).
- d) Mckinnon et al. (US 6175565 B1).
- e) Vander Meiden (US 6553116 B1).
- f) Hakim et al. (US 20020167943).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew C. Lee whose telephone number is (571)272-3131. The examiner can normally be reached on Monday through Friday from 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew C Lee/
Examiner, Art Unit 2476 <2Q10:01_15>
/Ayaz R. Sheikh/
Supervisory Patent Examiner, Art Unit 2476